

## **REMARKS**

Reconsideration and withdrawal of the rejections of this application and consideration and entry of this paper are respectfully requested in view of the herein remarks, which place the application in condition for allowance.

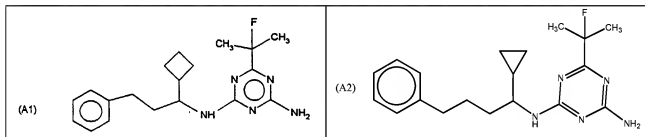
### **I. STATUS OF CLAIMS AND FORMAL MATTERS**

Claims 3, 6-9 and 12-22 are now pending in this application. Claims 3, 6-9 and 12-21 have not been amended. New claim 22 has been added which represents the elected species under examination. No new matter has been added.

It is submitted that the claims, herewith and as originally presented, are patentably distinct over the prior art cited in the Office Action, and that these claims were in full compliance with the requirements of 35 U.S.C. § 112. The amendments of the claims, as presented herein, are not made for purposes of patentability within the meaning of 35 U.S.C. §§§§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

### **II. COMMENT ON RESTRICTION REQUIREMENT**

The applicants' argument that the compounds of (A1) and (A2) – see Table below:



should be examined together was not found persuasive in the previous Office Action and therefore, the applicants confirm that the scope of the claims under examination are compositions which comprises a combination of:

herbicide (A2) - 4-amino-6-(1-fluoro-1-methylethyl)-2-(3-phenyl-1-cyclopropylamino)-1,3,5-triazine and

herbicide (B) represented by fenoxaprop (see e.g., herbicide (B1.33)).

### **III. COMMENT REGARDING ALLOWANCE OF CLAIMS IN PARALLEL APPLICATION BEFORE THE EPO (EP 1 113 790)**

The Examiner acknowledged receipt of the allowed claims from the parallel EP application, but appeared to misinterpret the purpose of their submission. While the USPTO is not obligated to accept the allowance of claims from another jurisdiction (even if the present application had qualified as being eligible for the Patent Prosecution Highway), the submission of the allowed claims can be considered as evidence as being representative of a factual finding by one of ordinary skill in the art.

This is especially appropriate given the similarities between the patent laws between the USPTO and EPO:

35 U.S.C.	European Patent Convention (EPC) Article
<p><b>102 (Conditions for patentability; novelty and loss of right to patent)</b> A person shall be entitled to a patent unless –</p> <p>(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or</p> <p>(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or</p> <p>(c) the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language; or</p>	<p><b>54 (Novelty)</b></p> <p>(1) An invention shall be considered to be new if it does not form part of that state of the art.</p> <p>(2) The state of the art shall be held to comprise everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the European patent application.</p> <p>(3) Additionally, the content of European patent applications as filed, the dates of filing of which are prior to the date referred to in paragraph 2 and which were published on or after that date, shall be considered as compromised in the state of the art.</p> <p>(4) Paragraphs 2 and 3 shall not exclude the patentability of any substance or composition, comprised in the state of the art, for use in a method referred to in Article 53(c), provided that its use for any such method is not comprised in the state of the art.</p> <p>(5) Paragraphs 2 and 3 shall also not exclude the patentability of any substance or composition referred to in paragraph 4 for any specific use in a method referred to in Article 53(c), provided that such use is not comprised in the state of the art.</p>
<p><b>103 (Conditions for patentability; non-obvious subject matter)</b></p> <p>(a) A patent may not be obtained though the invention is not identically disclosed or described</p>	<p><b>56 (Inventive Step)</b></p> <p>An invention shall be considered as involving an inventive step if, having regard to the state of the</p>

<p>as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.</p>	<p>art, it is not obvious to a person skilled in the art. If the state of the art also includes documents within the meaning of Article 54, paragraph 3, these documents shall not be considered in deciding whether there has been an inventive step.</p>
<p><b>112 (Specification – 1<sup>st</sup> paragraph)</b> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.</p> <p>The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.</p>	<p><b>83 (Disclosure of the Invention)</b> The European patent application shall disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.</p>
<p><b>112 (Specification – 2<sup>nd</sup> paragraph)</b> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.</p>	<p><b>84 (Claims)</b> The claims shall define the matter for which protection is sought. They shall be clear and concise and be supported by the description.</p>

### **III. THE 35 U.S.C. 112, 1<sup>ST</sup> PARAGRAPH REJECTION (“Written Description”) HAS BEEN OVERCOME**

Claims 3, 6-9 and 12-21 were rejected as allegedly failing to comply with the written description requirement, i.e. the applicants were alleged to have had no possession of the invention of the subject matter as claimed at the time of filing the application.

The initial burden for establishing lack of possession of the invention resides with the Office.<sup>1</sup> Again, the Examiner provides little to no explanation was given as to why the present case fails to meet the written description requirement especially when the scope of the claims

<sup>1</sup> MPEP 2163, section I. A. (“There is a *strong presumption that an adequate written description of the claimed invention is present when the application is filed*. In *re Wertheim*, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976) (“we are of the opinion that the *PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims.*”) - emphasis added by applicants.

examined has been limited to the combination of (A2) and B1.3.3 (which was confirmed by the Examiner in the previous Office Action).

Moreover, any explanation for establishing lack of possession must overcome a significant evidentiary hurdle as it has previously been held that “To satisfy the description requirement of section 112, first paragraph, an application must contain sufficient disclosure, expressly or inherently, to make it clear to one skilled in the art that the appellant was in possession of the subject matter claimed...’[A] statement of the appellant’s invention [in his specification] which is as broad as appellant’s broadest claims’ is sufficient to meet this requirement.” see *In re Eickmeyer*, 202 USPQ 655, 662 (CCPA 1979).

Given this low threshold for complying with the written description requirement, the Office Action has not met the initial burden for establishing lack of possession and as such the rejection may be withdrawn. The applicants provide further explanation regarding the individual rejections below:

#### **Heterocycle rejection**

With regard to elected species, this rejection is moot as there are no additional heterocyclic groups besides the triazine which is part of (A2).

With regard to the rejection for the full scope of the claims based on having “no guidance how all the heterocyclic groups can be prepared and will be useful for such broad combinations as has been claimed.”, there is no explanation as to why specific guidance is needed.

One of ordinary skill in the art would be able to determine the type of heterocycles defined in the claims (e.g. “heterocyclyl having 3 to 6 ring atoms and 1 to 3 hetero ring atoms selected from the group consisting of N, O and S,”) and would be able to determine how to synthesize this moiety onto the base structure of compounds (II), (III), (IV) and (V).

Even the Examiner’s language of the rejection suggests uncertainty that the applicants’ lacked possession of the invention (“It appears that Applicant has no possession of the claimed subject matter as a whole at the time the application was filed.”).

In addition, when confronted with similar language in the claims of the EP application, one of ordinary skill in the art (i.e. the EP examiner), allowed the claims with similar language to pass to issue.

Given the lack of evidence and explanation in support of this rejection, there is no basis to assert that the applicants' lacked possession of this portion of the invention.

#### **Derivative rejection**

With regard to the "derivatives" rejection, while the use of case law is permitted to supplement or even be the primary basis for a rejection, the relevance of the case law cited is proportional to the factual relation to the application under examination. In the present case, the Examiner citation of *University of Rochester v. G.D. Searle* is misplaced as the claims at issue in that decision were all related to an assay for "selectively inhibiting PGHS-2 activity in a human host by **administering a non-steroidal compound** that selectively inhibits the activity of the PGHS-2 gene product to [or in] a human host in need of such treatment." In that case, no description was given as to the structural features which would have given rise to the claimed inhibitory activity.

This is not the issue in the present case, the applicants have given a basic structural definition for the compounds used in the invention (see formulas (II)-(V) and the specific names for herbicide (B)) and one of ordinary skill in the art would be able to determine whether a compound was a derivative of herbicides (A) or (B). (The Examiner appears to recognize this as the recitation of the *Rochester* decision is followed by an explanation of the requirements for adequate description which the applicants have met by their reference to formulas (II)-(V) and the specific names for herbicide (B)).

If the rejection is a reflexive one simply based on the appearance of the term "derivative", it is noted that as of the date of this response, 46,368 U.S. patents have the term in at least one claim, including 32 by the Examiner of this application.

In addition, when confronted with similar language in the claims of the EP application, one of ordinary skill in the art (i.e. the EP examiner), allowed the claims with similar language to pass to issue.

(With regard to the "derivative" rejection, if this is the only matter preventing allowance of the claims, the Examiner may delete this term via an Examiner's Amendment)

#### **Synergism rejection**

This is the least understood of the three rejections as it is well known that there is no requirement of synergism for patentability. "A requirement for "synergism" or a "synergistic effect" is *nowhere found in the statute, 35 U.S.C.* When present, for example in a chemical

case, synergism may point toward nonobviousness, but its absence has no place in evaluating the evidence on obviousness. The more objective findings suggested in *Graham*, supra, are drawn from the language of the statute and are fully adequate guides for evaluating the evidence relating to compliance with 35 U.S.C. § 103.” *Bowser Inc. v. United States*, 388 F. 2d 346, 156 USPQ 406 (Ct. Cl. 1967)(emphasis added).

Although this is in the context of obviousness, there is no requirement for synergism within 35 U.S.C. If it is believe that the showing of synergy to overcome a rejection based on obviousness does not support the full scope of the claim, the rejection is not based on written description, but maintaining the obviousness rejection for the claims alleged to not be supported by the evidence of record (which is addressed below).

#### **IV. THE 35 U.S.C. 112, 2<sup>nd</sup> PARAGRAPH REJECTION (“Enablement”) HAS BEEN OVERCOME**

Claims 2-4, 6-9 and 11-21 were rejected as being non-enabled for other combinations of herbicides besides with (A1) or (A2) for synergism. As noted above, there is no statutory requirement for synergism. The applicants may provided evidence of synergism or unexpected results as part of secondary considerations for the purposes of obviousness, but it is not required for the purposes of enablement. One of ordinary skill in the art would be able to make the combinations encompassed by the applicants’ claims absence evidence to the contrary, however, as is described below, these combinations are unobvious in view of the prior art.

#### **III. THE 35 U.S.C. 103 REJECTION HAS BEEN OVERCOME**

Claims 2-4, 6-9 and 11-13 were rejected as being obvious over the combined teachings of Giencke et al. (U.S. Patent 6,239,071 - “Giencke”), Zindel et al. (WO 98/34925 - “Zindel”); Hirata et al. (A: EP 467 204; B: EP 469 406; C: EP 471 221; D: EP 471 284), Takematsu (Abstract of JP 04095003); Hirata et al. (A: Abstract of JP 7267804; B: Abstract of JP 7267805) and applicants disclosure on page 27.

The applicants maintain their response from their previous responses filed as the only rebuttal in the previous Office Action was merely a statement that applicants’ arguments were unpersuasive with no explanation as to why this was believed to be so.

When, as here, the applicants present a reasonable rebuttal, whether buttressed by experiment, prior art references, or argument, *the entire merits of the matter are to be reweighed*. *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986). The applicants' arguments should not have been judged for their knockdown ability with respect to the rejection.<sup>2</sup>

As noted above, the applicants have provided evidence of secondary considerations with regard to unexpected results and synergistic effects which is not taught or suggested by the combination of Giencke, Zindel, Hirata and Takematsu.

Moreover, since the final rejection, the USPTO and the EPO have announced their cooperation in the Patent Prosecution Highway. Although the present application does not qualify for this program, it is still instructive to note that claims substantially similar to those pending in the present application were allowed in the corresponding EP application (now EP 1113720 B1).

Hirata et al. (A: EP 467 204; B: EP 469 406; C: EP 471 221; D: EP 471 284) represents references D1-D4 considered in the EP application now allowed;

Takematsu (Abstract of JP 04095003) represents D5 considered in the EP application now allowed;

Hirata et al. (A: Abstract of JP 7267804; B: Abstract of JP 7267805) represents D6 and D7 considered in the EP application now allowed.

The Examiner cited the references cited by the applicants' on page 27 of the specification which includes the parallel WO application of Gienke et al. (US 6239071 is the parallel US application for WO 97/08156) and Hoechst (WO 98/34925). However, these applications merely recited that the compounds for formula (II) – (VII) were previously known. This does not teach or suggest the inventive combination of the claimed invention.

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<sup>2</sup> "When prima facie obviousness is established and evidence is submitted in rebuttal, the decision-maker *must start over*. . . . *An earlier decision should not*, as it was here, be considered as set in concrete, and applicant's rebuttal evidence then *be evaluated only on its knockdown ability*. Analytical fixation on an earlier decision can tend to provide that decision with an undeservedly broadened umbrella effect. Prima facie obviousness is a legal conclusion, not a fact. Facts established by rebuttal evidence must be evaluated along with the facts on which the earlier conclusion was reached, *not against the conclusion itself*. . . . [A] final finding of obviousness may of course be reached, but such finding will rest upon evaluation of all facts in evidence, uninfluenced by any earlier conclusion reached by an earlier board upon a different record." *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

The applicants' claims as examined has been confirmed to be the combination of the herbicide (A2) and fenoxaprop and none of the cited references disclose this specific combination within or the unexpected results for this combination.

For these reasons, the applicants claimed invention is unobvious over the combination of Giencke , Zindel, Hirata, Takematsu and the applicants recitation on page 27 of the specification.



**CONCLUSION**

In view of the remarks and amendments herewith, the application is believed to be in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. The undersigned looks forward to hearing favorably from the Examiner at an early date, and, the Examiner is invited to telephonically contact the undersigned to advance prosecution. The Commission is authorized to charge any fee occasioned by this paper, or credit any overpayment of such fees, to Deposit Account No. 50-0320.

Respectfully submitted,  
FROMMER LAWRENCE & HAUG LLP

By: /Howard C. Lee/  
Marilyn M. Brogan      Howard C. Lee  
Reg. No. 31,233      Reg. No. 48,104  
Telephone:      (212) 588-0800  
Facsimile:      (212) 588-0500